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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY ANDREAS MESERTH and
HEATHER N. STERLING

Appeal 2008-2296
Application 10/075,861
Technology Center 2100

Decided: November 19, 2008

Before JOSEPH L. DIXON, ST. JOHN COURtenAY, and
THU A. DANG, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1-21. We have jurisdiction under
35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

THE INVENTION

Appellants' invented a system and method for controlling real-time display with a user positionable icon. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1 A method of representing real time data in a graphical format on a display of a data processing system, comprising:

providing a user positionable icon as a portion of the display;

determining the position of the icon; and

refreshing the graphical representation responsive to receiving a new data point, wherein the position of the icon determines how much historical data is retained in the refreshed display.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Takahashi	US 5,999,162	Dec. 7, 1999
Holzman	US 6,064,401	May 16, 2000
Balassanian	US 6,507,349 B1	Jan. 14, 2003
		(filed Jan. 6, 2000)

REJECTIONS

The Examiner rejected claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Takahashi and further in view of Balassanian.

The Examiner rejected claims 15-21 under 35 U.S.C. 103(a) as being unpatentable over Takahashi and further in view of Holzman.

Rather than reiterate the conflicting viewpoints of the Examiner and Appellants regarding the above-noted rejection, we refer to the Examiner's Answer (mailed Jun. 18, 2007) for the reasoning in support of the rejections, and to Appellants' Brief (filed Mar. 8, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have carefully considered Appellants' Specification and claims, the applied prior art references, and the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we determine the following.

PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162(citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

ISSUE

Has the Examiner set forth a sufficient initial showing of obviousness?

ANALYSIS

With respect to independent claim 1, Appellants argue that the Section 103(a) rejection is improper because the cited references do not disclose or suggest all claim limitations. Specifically, Appellants argue that the user positionable icon is provided as a portion of the display and Takahashi does not teach the user positionable icon as a portion of the display. (App. Br. 4-5).

The Examiner relies upon the dashed line in figure 10 of Takahashi for the "winding-up position" as a teaching for determining the position of the icon (predetermined). The Examiner further relies upon refreshing the graphical representation responsive to receiving a new data point and columns 2 and 4 of Takahashi to support the Examiner's finding that the position of the icon, which the Examiner equates to the winding up position line, would determine how much historical data is retained in the refreshed display. (Ans. 3-4). While we agree with the Examiner that the end result of moving the graphical representation when refreshed to retain a predetermined amount of historical data is similar between Takahashi and the claimed invention, it is the manner in which the claimed invention achieves the end result which is being specifically claimed.

From our review of the teachings of Takahashi and the specific portions relied upon by the Examiner, we find no express or implied teaching that the dashed line shown in the display of figure 10 of Takahashi or the dashed lines on the display in any of the other figures of Takahashi are actually visible on the display and could be correlated as "icons" that are positionable by the user. While the Examiner identifies the "predetermined position" and that the "operator can freely adjust the wind up speed and position" in column 10 of Takahashi, Takahashi is silent as to how the user or operator would implement those changes to the predetermined position. Here, we are left to speculate as to how the wind-up mechanism interfaces with the user. We note that in figure 7, box 585, Takahashi identifies that x=winding-up position as a preset and in figure 9, box 96, identifies that x=winding-up position, but Takahashi does not teach or suggest any methodology for setting that winding-up value.

While the Examiner appears to rely upon the teachings of Takahashi at page 3 of the Answer, the Examiner also states that Takahashi fails to show the user positionable icon as a portion of the display and relies upon the teachings of Balassanian to teach a user-positionable icon as a portion of a display controlling of the amount of information to be retained on screen. Furthermore, the Examiner does not identify the portions of Balassanian relied upon in the statement of the rejection, but identifies figure 4D, item 405, and figures 4I, 4J, 4L, and 4M and their corresponding text to evidence the use of user-positionable icons on the display. (Ans. 9-10). We disagree with the Examiner's reliance upon the teachings of Balassanian since at most item 405 is a movable icon/cursor with no corresponding function regarding

quantity of data (historical, real time, or graphical format). Moreover, the Examiner's reliance upon items 480 and 485, which merely resize the window, has nothing to do regarding quantity of (historical, real time, graphical format) data and does not suggest the modification of Takahashi as advanced by the Examiner.

Accordingly, we agree with Appellants that the combination of Takahashi and Balassanian does not teach or fairly suggest "a user positionable icon as a portion of the display... wherein the position of the icon determines how much historical data is retained in the refreshed display" of independent claim 1. Therefore, Appellants have shown error in the Examiner's initial showing of obviousness, and we cannot sustain the rejection of independent claims 1 and 8 and their respective dependent claims 2-7 and 9-14.

With respect to independent claim 15, we note that the teachings of Holzman relied upon by the Examiner at pages 5-6 and 11-12 of the Answer do not teach the claimed "a user-positionable icon as part of the graphical representations... wherein the position of the icon along the horizontal axis determines how much historical data is retained in the refreshed graphical representation" of independent claim 1 as advanced by the Examiner therein. Therefore, Appellant has shown error in the Examiner's initial showing of obviousness, and we cannot sustain the rejection of independent claim 15 and its respective dependent claims 16-21.

We note that Appellant's Brief does not provide any correlation of the "means" limitations in independent claims 8 and 15 to the corresponding structure, acts, or materials in the Specification to interpret the claims in

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light of 35 U.S.C. § 112, sixth paragraph. The Examiner should consider such any correlation in any further action on the merits.

CONCLUSIONS OF LAW

We have reversed the rejection of claims 1-21 under 35 U.S.C. § 103(a).

ORDER

REVERSED

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